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10/538,336	06/10/2005	Johannis Friso Rendert Blacquiere	NL021272	1556

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EXAMINER

LU'ONG, ALAN H

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/538,336

**Applicant(s)**

BLACQUIERE ET AL.

**Examiner**

ALAN LUONG

**Art Unit**

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 08/24/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is the initial Office Action based on the 10/538,336 application filed on June 10, 2005. Claims 1-17, as a 371 of PCT/IB03/05217 filed on 11/14/2003, which claims benefit of European application No. (EPO) 02080273.2; filed on 12/13/ 2002; are currently pending and have been considered below.

### ***Claim Objections***

2. Claims 15 is objected to because of the following informalities: at line 2 of claim, recites "marling" is typo of "marking". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-13, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0136533 A1 published by Hideo Ando et al. (hereinafter Ando); in view of US 2003/0204848 A1 published by David J. Cheng et al. (hereinafter Cheng)

**Regarding claim 1:** Fig. 1 of Ando depicts "a system" includes "a recording apparatus [101] to [104]" for recording programs from "a receiver " includes input section [107] and

Art Unit: 2623

tuner [108] " that receive receivable programs" as audio, video and data signals, and in Fig. 9; Ando also discloses "a comparator" [MPU 101] compares a primary text information as "a recorded search instruction" stored in "a recordable medium [10] with program information on the receivable programs and the primary text information as "a recorded search instruction" stored in "the recordable medium [10] (**Ando, (¶0028 to ¶0032), (¶103 to ¶107) and ¶0130 to ¶145)**)

However, Ando fails to disclose "if the particular one of the receivable programs matches the recorded search instruction stored in the recordable medium [10] to record a particular one of the receivable programs on the recordable medium.

In an analogous art directed toward a similar problem namely improving the results from matching the recorded search instruction. Fig. 3 of Cheng illustrates other record events [232] as a smart record event wherein the user indicates that he or she desires to record all programs that have a " particular one of the receivable programs matches the recorded search instruction stored in the recordable medium ". (**Cheng, ¶0035, ¶0036**). Accordingly, it would have been obvious to someone having ordinary skill in the art at the time of the invention was made to modify a recording apparatus of Ando with a recording process system as taught by Cheng to prevent conflict at least one already recorded program to free sufficient space to record the program matching".

**Regarding claim 2:** A system as claimed in claim 1, Fig. 12 of Ando shows "wherein the recorded search instruction comprises an indication of a specific type of program to be recorded on the recordable medium" (**Ando, ¶0177 to ¶0189**). .

**Regarding claim 3:** Same limitation of claim 1. So, claim 3 has the same ground rejection as claim 1. (See discussion in claim 1)

**Regarding claim 4:** A recording apparatus as claimed in claim 3, Fig. 12 of Ando shows "wherein the recorded search instruction comprises an indication of a specific type of program to be recorded on the recordable medium" (**Ando, ¶¶0177 to ¶0189**). .

**Regarding claim 5:** A recording apparatus as claimed in claim 4, Fig. 1 of Ando shows further comprising "an information receiver [108] for receiving the program information indicating a type and times of occurrence of the receivable programs to supply the program information to the comparator [MPU 101]" (**Ando, ¶¶0122 and ¶0177 to ¶0189**)).

**Regarding claim 6:** A recording apparatus as claimed in claim 5, wherein the information receiver comprises a teletext receiver [204] for scanning teletext pages containing the program information (**Ando, ¶0135**).

**Regarding claims 7, 8:** A recording apparatus as claimed in claim 3, Ando reference is deficiency with "further comprising a controller for checking whether a still free space on the recordable medium is sufficient to record the receivable program matching the specific type of program, to record the program matching in the free space, if sufficient, or to delete at least one already recorded program to free sufficient space to record the program matching".

In an analogous art directed toward a similar problem namely improving the results from free space on the recordable medium for recording , Cheng teaches a recording device"

further comprising a controller for checking whether a still free space on the recordable medium is sufficient to record the receivable program matching the specific type of program, to record the program matching in the free space, if sufficient, or to delete at least one already recorded program to free sufficient space to record the program matching".(Cheng, ¶0052, ¶0054, ¶0055)

Therefore, it would have been obvious to someone having ordinary skill in the art at the time of the invention was made to modify a recording apparatus of Ando with a recording process system as taught by Cheng to delete at least one already recorded program to free sufficient space to record the program matching".

**Regarding claim 8:** A recording apparatus as claimed in claim 7, Cheng also teaches a series record event [226] is scheduled the recording device to record each episode of "the already recorded program", the series record event 226 "comprises a recorded program recorded earliest". (Cheng, ¶0033)

**Regarding claim 9:** A recording apparatus as claimed in claim 3, wherein the recording apparatus [102] is a recorder for recording programs on an optical medium [10], and wherein the programs are TV-broadcast programs (Ando, ¶0093).

**Regarding claim 10:** A recording apparatus as claimed in claim 3, Fig. 1 of Ando shows "wherein the recording apparatus is a DVD-recorder "(Ando; ¶0102).

**Regarding claim 11:** A recording apparatus as claimed in claim 1, Fig. 1 of Ando discloses the recordable medium is a removable recordable medium [an optical disc [10] as DVD type], (¶0201), the recording apparatus [101 to 104] further comprises a

further storage medium [105] (**¶0105**), and the comparator is adapted for further comparing the recorded search instruction with program information on programs recorded on the further storage medium, to record on the recordable medium a particular one of the programs recorded only if the particular one of the programs recorded matches the recorded search instruction (see claim 1 rejection).

**Regarding claims 12, 13:** A recordable medium for use in the system of claim 1, Fig. 1 of Ando depicts the recordable medium [10] comprising the recorded search instruction (**Ando, Figs. 1, 9, ¶0019 to ¶0032**) wherein comprises an indication [IDCD] of a specific type of program to be recorded on the recordable medium (**¶0185 to ¶0189**).

**Regarding claim 16:** A method of recording programs on a recordable medium has the same limitation of claim 1. Claim 16 has the same ground rejection of claim 1.

**Regarding claim 17:** A method as claimed in claim 16, claim 17 has the same limitation of claims 12 and 13. So, claim 17 has the same ground rejection of claims 12 and 13 combination.

5. Claims 14,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0136533 A1 published by Hideo Ando et al. (hereinafter Ando) and US 2003/0204848 A1 published by David J. Cheng et al. (hereinafter Cheng), in view of US 2003/0012562 A1 published by Nabil M. Lawandy et al. (hereinafter Lawandy).

**Regarding claim 14:** A recordable medium as claimed in claim 12, neither Ando nor Cheng teaches "the recordable medium further comprises a visible marking indicating the recorded search instruction".

Art Unit: 2623

In an analogous art directed toward a similar problem namely improving the results from a visible marking indicator ; Lawandy teaches “a visible marking indicator”[432] as marking for “the recorded search instruction” (**Lawandy, ¶0088**). Therefore, it would have been obvious to someone having ordinary skill in the art at the time of the invention was made to modify a recording apparatus of Ando and Cheng with a a visible marking as taught by Lawandy to provide enhanced identification, authentication and encoding capabilities for various articles of manufacture, including media containing optically readable information. More specifically, a need exists to rapidly produce images, text, or other optically encoded information on the read side of optical media. Further more, the method should not interfere with the performance of data readout from the optical media.( **¶0015**)

**Regarding claim 15:** A recordable medium as claimed in claim 13, neither Ando nor Cheng teaches “wherein the visible marking comprises a text and/or image label indicating the specific type of program to be recorded.”

In an analogous art directed toward a similar problem namely improving the results from a visible marking indicator; Lawandy teaches “a visible marking indicator” [432] as marking for a text and/or image label indicating the specific type of program to be recorded.” (**Lawandy, ¶0054, ¶0098**). Therefore, it would have been obvious to someone having ordinary skill in the art at the time of the invention was made to modify a recording apparatus of Ando and Cheng with a a visible marking as taught by Lawandy to provide a need exists to rapidly produce images, text, or other optically



Art Unit: 2623

encoded information on the read side of optical media. Further more, the method should not interfere with the performance of data readout from the optical media.( ¶0015)

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALAN LUONG whose telephone number is (571)270-5091. The examiner can normally be reached on Mon.-Thurs., 8:00am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. L./

Examiner, Art Unit 2623

Application/Control Number: 10/538,336

Page 9

Art Unit: 2623

/Scott Beliveau/

Supervisory Patent Examiner, Art Unit 2623